

Attr. Docket No.: VPI/99-109 DIV US
 Application No.: 10/779,532
 Applicants: Green et al.

REMARKS

The Claim Amendments

$$\begin{array}{c} \text{N} \quad \text{CR}_2 \\ \diagdown \quad / \\ \text{N} \\ / \quad \backslash \\ \text{R}_3 \end{array}$$

Applicants have amended claims 1 and 12 to delete as a radical for X-Y-Z. Support may be found in the corresponding originally-filed claims. Applicants have further amended claim 12 to recite a method for treating rheumatoid arthritis. Support may be found throughout the specification and in originally-filed claim 16. Applicants have amended claim 11 to correct a typographical error. Applicants have canceled claims 13-24 and added claims 25-27. Support for claim 25 may be found throughout the specification and in originally-filed claims 1 and 6. Support for claims 26 and 27 may be found throughout the specification and in originally-filed claims 11 and 16. None of these amendments adds new subject matter. Their entry is requested.

The Response

The Rejection Under 35 U.S.C. §112, First Paragraph

The Examiner has rejected claims 12-24 under 35 U.S.C. §112, first paragraph. The Examiner states that the specification enables a method for treating rheumatoid arthritis but contends that the specification does not reasonably provide enablement for the treatment of any diseases state or condition that can be alleviated by a protein kinase inhibitor generally.

In order to expedited prosecution, applicants have amended the claims to recite a method of treating rheumatoid arthritis, thus obviating this rejection.

The Rejection Under 35 U.S.C. §112, Second Paragraph

The Examiner has rejected claims 15-22 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have cancelled claims 15-22, thus obviating this rejection.

The Rejection Under 35 U.S.C. §102(b)

The Examiner has rejected claims 1-2 and 11-24 under 35 U.S.C. §102(b) as being anticipated by Anantanarayan et al. (WO 98/52940, hereafter "the '940 application).

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Specifically, the examiner states that the instant claims read on compounds disclosed in the '940 application, including Examples A-213, A-220-222 and A-245-248.

Applicants have amended claims 1 and 12 so that the five-membered ring comprising X-Y-Z no longer encompasses pyrazoles, thus obviating this rejection. In addition, new claim 25 does not encompass any of the compounds exemplified in the '940 application.

The Rejection Under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-2, 8 and 11-24 under 35 U.S.C. §103(a) as being unpatentable over the '940 application. Specifically, the Examiner contends that the '940 application teaches a generic group of compounds that embraces applicants' instantly claimed compounds and discloses use of the compounds as having kinase inhibitory activity. The Examiner states that it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the '940 application, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties and the same use as pharmaceutical therapeutic agents. The Examiner further contends that one of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. Applicants traverse.

The Manual of Patent Examining Procedure (MPEP) 2144.08 II.A.4. states that "a *prima facie* case of unpatentability requires that the teachings of the prior art suggest the claimed compounds to a person of ordinary skill in the art (emphasis in original; quoting various cases). This is not the case here. In the '940 application, the genus of formula (I) encompasses a vast number of compounds. For example, the possible substituents for radical R¹ cover three pages, those for radical R² cover almost two pages, while the substituents for radicals R³ and R⁴ cover a page and half a page, respectively (see pages 4-9 of the '940 application). In addition, even where the '940 application provides preferred substituents for radicals R¹-R⁴ (see, e.g., pages 25-35), the subgenera still encompass an extremely large number of compounds. Further, even though the preferred subgenera provided in the '940 application are large, they do not encompass the compounds recited in claim 8 or the genus provided in claim 25. Thus, contrary to the

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Examiner's assertion, the '940 application does not teach or disclose compounds or genera that would lead one skilled in the art to select the compounds recited in claim 8 or the genus provided in claim 25. Given this lack of teaching in the '940 application, one skilled in the art would have no motivation to make the compounds of claim 8 or the genus of claim 25.

Conclusion

Applicants request that the Examiner enter the above amendments, consider the accompanying arguments, and allow the claims to pass to issue. Should the Examiner deem expedient a telephone discussion to further the prosecution of the above application, applicants request that the Examiner contact the undersigned at his convenience.

Respectfully submitted,



Karen E. Brown
Registration No. 43,866
Attorney for Applicants
c/o Vertex Pharmaceuticals Incorporated
130 Waverly Street
Cambridge, MA 02139-4242
Tel.: (617) 444-6168
Fax.: (617) 444-6483